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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,106	11/09/2001	Daniel K. Schiffer	KCC-15,891	3014
35844	7590	09/08/2005	EXAMINER	
PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD HOFFMAN ESTATES, IL 60195			SPERTY, ARDEN B	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Office Action Summary*

Application No.

10/036,106

Applicant(s)

SCHIFFER ET AL.

Examiner

Arden B. Sperty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-26,31,35,37-54 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-26,31,35,37-54 and 56-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **NON-FINAL OFFICE ACTION**

1. Applicant's arguments and request for reconsideration, filed 6/22/05, have been entered and fully considered. Portions of Applicant's arguments have been found persuasive, as detailed below. Despite this advance, the claims (version 2/09/05) remain rejected in view of references newly relied upon.

#### ***Response to Arguments***

2. Applicant first asserts that the examiner has misinterpreted the teachings of Burns, in the rejection of claims 53 and 56-58, to conclude that a biodegradable sanitary napkin composite is taught. The examiner's conclusion was based on Burns' inclusion of biodegradable polymers as desirable materials (col. 6, lines 42-43). While Burns recognizes thermoplastic polymers as within the scope of the invention, the examiner must concede in light of Applicant's arguments that an explicit teaching of a "fibrous nonwoven web including a biodegradable thermoplastic polymer" is lacking. For this reason, the 35 USC 102(e) rejection is withdrawn, however the claims are currently rejected under 35 USC 103(a) as obvious in view of Burns, because the teachings of Burns clearly suggest biodegradable materials.

3. The argument that Burns does not teach each film layer including a biodegradable thermoplastic polymer is not persuasive. Burns teaches a backsheet 40, which may comprise multiple layers (col. 6, lines 1-10), and further teaches that materials for these layers include biodegradable thermoplastic polymers (col. 6, lines 40-43). Applicant further argues, on page 3 of the response, that Burns teaches only

one group that is compostable or biodegradable. It should be noted that the “one group” referred to by Applicant is indeed intended for the stretch-thinned filled thermoplastic film. Therefore, it seems that “one group” is more than sufficient to anticipate Applicant’s claim features. Further, it is presumed, with respect to claim 56, that the additional backsheet layers are made of the same material as the disclosed backsheet layers. Therefore it is indicated that stretch-thinned filled thermoplastic film layers are intended, thus anticipating the limitations of claim 56. Regardless of this position, the 35 USC 102(e) rejection is withdrawn due to a lack of explicit disclosure of a fibrous nonwoven web including a biodegradable thermoplastic polymer. However, the positions described above are maintained insofar as they are applied to the presently stated 35 USC 103(a) rejections of the claims.

4. On page 4 of Applicant’s response, the dimensions of Burns’ figures are inappropriately relied upon as evidence. While the figures can be relied upon for many aspects, figures are not drawn to scale unless otherwise noted, therefore Applicant’s argument is unpersuasive.

5. Applicant also makes a very confusing statement on page 4, wherein he/she recites, “Burns, Jr., et al. also does not disclose a breathable film in which one film layer includes a mixture of filler particles and biodegradable thermoplastic polymer and constitutes 50-100% of the thickness of the film.” If there is one film layer, how can it not constitute 100% of itself; if there is one film layer, how can it only constitute 50% of itself? The language of the statement is a reflection of the language used in claim 21.

Due to the confusing language, the argument cannot be fully considered, and claim 21 is rejected under 35 USC 112, second paragraph, below.

6. Regarding the arguments pertaining to claim 50, also on page 4, the argument that Burns does not teach each film layer including a biodegradable thermoplastic polymer is not persuasive. Burns teaches a backsheet 40, which may comprise multiple layers (col. 6, lines 1-10), and further teaches that materials for these layers include biodegradable thermoplastic polymers (col. 6, lines 40-43). The film is a stretch-thinned filled thermoplastic film. It is presumed that the additional backsheet layers are made of the same material as the disclosed backsheet layers. Therefore it is indicated that stretch-thinned filled thermoplastic film layers are intended, thus anticipating the requirements of claims 50 and 53. Still, the rejections are withdrawn due to a lack of explicit teaching by Burns of a fibrous nonwoven web including a biodegradable thermoplastic polymer, although the biodegradable fibrous nonwoven would have been obvious as stated below.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. If there is one film layer, how can it not constitute 100% of itself; if there is one film layer, how can it only constitute 50% of itself?

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 21-26, 31, 35, 37-39, 41, 44-54, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5374259 to Takahashi et al.

11. The Takahashi reference teaches biodegradable films and nonwovens used in disposable personal care articles (col. 1, lines 6-13). Polymeric materials include those claimed by Applicant (col. 4, lines 34-64). Breathable films made from the biodegradable polymeric materials are filled and stretched to provide air-permeability (col. 7, line 65- col. 8, line 12). Films and nonwovens are bonded together as desired to form a diaper (col. 12, line 67-col. 13, line 2). The films and nonwovens are used as various parts of a diaper, so as to provide a final composite which is completely biodegradable (col. 2, lines 5-32). Although the reference is not concerned with the layering sequence of films and nonwovens, the sequence of laminated films and nonwovens varies in diaper construction according to desired functions. Determining and varying an optimal sequence of layers is basic in the science of materials engineering. Absent a showing of unexpected results with a specific number of layers and layer sequence, it would have been obvious to one of ordinary skill in the art to assemble the biodegradable films and nonwovens as desired for optimal results.

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12. The layers may be formed from the same material to facilitate thermal bonding (col. 9, lines 24-29). The examiner takes official notice that additional bonding means, such as adhesive bonding, are known to those of ordinary skill in the art and would have been obvious to employ as needed.

13. Spunbond and meltblown nonwovens are specifically recited by the reference (col. 8, lines 20-26).

14. Regarding claims 44-47, and 50, the reference is not concerned with the specific amount of filler and polymeric material. Absent a showing of unexpected results with specific proportions, it would have been within the ordinary level of skill of one in the art to determine these amounts.

15. Regarding claims 48-49, stretching preferences would have been obvious to one of ordinary skill in the art.

16. Claims 40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi as applied to claim 21 above, and further in view of Roberts, "β-cyclodextrin Molecules and Their Use in Breathable Barriers."

17. The Takahashi reference teaches a filled, stretch-thinned biodegradable film, wherein a variety of fillers may be used. While the references are silent with respect to organic or cyclodextrin fillers, Roberts teaches that β-cyclodextrin enhances moisture vapor permeability of polymeric barrier films. It would have been obvious to one of



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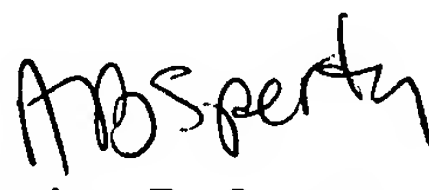
ordinary skill in the art to use cyclodextrin as a filler in the invention of Takahashi to enhance vapor permeability of the personal care product. (See Roberts section 1.3).

### **Conclusion**

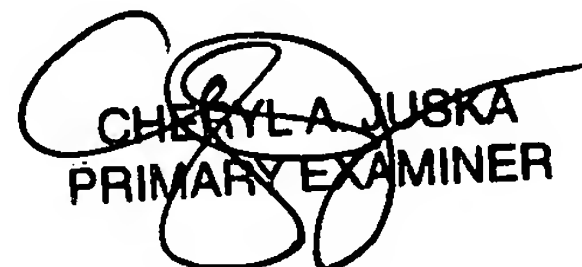
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Arden B. Sperty  
Examiner  
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Aug 29, 2005

  
CHERYL A. JUSKA  
PRIMARY EXAMINER